

In re Application of:

Kiyofumi SAKAGUCHI, et al.

Application No.: 09/161,774

Filed: September 29, 1998

For: PROCESS FOR PRODUCTION OF
SEMICONDUCTOR SUBSTRATE

Docket No. 03500.010530.4
(35.C10530 C1/D2)

Examiner: George R. Fourson, III

Group Art Unit: 2823

Confirmation No.: 8032

Date: June 30, 2006

**Attn.: Office of Patent Legal Administration
(Patent Term Extension)**

Mail Stop Petition

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Transmitted herewith is a Petition Under 37 C.F.R. § 1.181 and MPEP 2720 for Reconsideration of Patent Term Extension in the above-referenced application.

☒ No additional fee is required.

The fee has been calculated as shown below

CLAIMS AS AMENDED						
	(2) CLAIMS REMAINING AFTER AMENDMENT		(4) HIGHEST NO. PREVIOUSLY PAID FOR	(5) PRESENT EXTRA	RATE	ADDITIONAL FEE
TOTAL CLAIMS	8	MINUS	20	= 0	x \$25 \$50	\$0.00
INDEP. CLAIMS	2	MINUS	3	= 0	x \$100 \$200	\$0.00
Fee for Multiple Dependent claims \$180/\$360						\$0.00
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT---						\$0.00

- ☐ Verified Statement claiming small entity status is enclosed, if not filed previously.
- ☐ A check in the amount of \$_____ is enclosed.
- ☐ Charge \$_____ to Deposit Account No. 06-1205 to cover the Information Disclosure Statement fee. A duplicate copy of this sheet is enclosed.
- ☒ Any prior general authorization to charge an issue fee under 37 C.F.R. 1.18 to Deposit Account No. 06-1205 is hereby revoked. The Commissioner is hereby authorized to charge any additional fees under 37 C.F.R. 1.16 and 1.17 which may be required during the entire pendency of this application, or to credit any overpayment, to Deposit Account No. 06-1205. A duplicate copy of this paper is enclosed.
- ☐ A check in the amount of \$_____ to cover the fee for a _____ month extension is enclosed.
- ☐ A check in the amount of \$_____ to cover the Information Disclosure Statement fee is enclosed.
- ☒ Applicants' undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 530-1010. All correspondence should continue to be directed to our address given below.

Respectfully submitted,

/Daniel S. Glueck/
Daniel S. Glueck
Attorney for Applicants
Registration No.: 37,838

FITZPATRICK, CELLA, HARPER & SCINTO
30 Rockefeller Plaza
New York, New York 10112-3800
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DSG/cmg

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03500.010530.4 (35.C10530 C1/D2)

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
Kiyofumi SAKAGUCHI, et al.	:	Examiner: George R. Fourson, III
)	
Application No.: 09/161,774	:	Group Art Unit: 2823
)	
Filed: September 29, 1998	:	Confirmation No.: 8032
)	
For: PROCESS FOR PRODUCTION OF	:	
SEMICONDUCTOR SUBSTRATE	:	June 30, 2006

**Attn.: Office of Patent Legal Administration
(Patent Term Extension)**

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**PETITION UNDER 37 C.F.R. § 1.181 AND MPEP 2720
FOR RECONSIDERATION OF PATENT TERM EXTENSION**

Sir:

RELIEF REQUESTED

Applicants are in receipt of a Determination of Patent Term Extension under 35 U.S.C. § 154(b) dated June 13, 2006, that indicates that the patent term extension is zero days, and Applicants respectfully request that the same be recalculated to be 372 days.

FACTS

1. The subject application, which was filed on September 29, 1998, was involved in Interference No. 105,263, which was declared on October 21, 2004, as shown by the attached copy of the Declaration bearing that date.
2. The interference was terminated on October 27, 2005, as shown by the attached copy of a Judgment bearing that date.

ARGUMENT

Applications filed on or after June 8, 1995, and before May 29, 2000, shall have their term extended by the number of days in the period beginning on the date the interference was declared and ending on the date that the interference was terminated, up to a maximum of five years. 37 C.F.R. § 1.701; former 35 U.S.C. § 154(b)(1); MPEP 2720. The subject application was filed during that period, and was involved in an interference beginning on October 21, 2004, and ending on October 27, 2005, a total of 372 days. See Facts 1-2, *supra*.

FORMAL MATTERS

The need to file this paper arose from a U.S. Patent and Trademark Office error in the calculation of the patent term extension; accordingly, it is respectfully requested that no fee be charged to Applicants. If the U.S. Patent and Trademark Office requires that a fee

be charged in connection with this paper, then any such fee should be charged to Deposit Account 06-1205.

CONCLUSION

In view of the foregoing, Applicants respectfully request that the relief requested be granted.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should be directed to our address given below.

Respectfully submitted,

/Daniel S. Glueck/
Attorney for Applicants
Daniel S. Glueck
Registration No. 37,838

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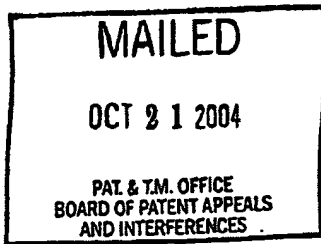
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UNITED STATES PATENT AND TRADEMARK OFFICE

DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES
BOX INTERFERENCE, WASHINGTON, D.C. 20231

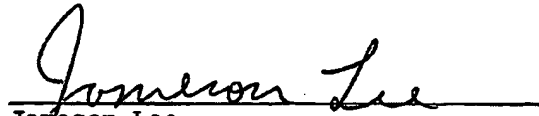
Filed by: Jameson Lee
Telephone: (703) 308-9797
Facsimile: (703) 305-0942



Applicants: Sakaguchi et al.
Application No.: 09/161,774
Filed: 09/29/98
For: Process for production of
semiconductor substrate

The above-identified application or patent has been forwarded to the Board of Patent Appeals and Interferences because it is adjudged to interfere with another application or patent. An interference has been declared. The interference is designated as No. 105,263.

Notice is hereby given the parties of the requirement of the law for filing in the Patent and Trademark Office a copy of any agreement "in connection with or in contemplation of the termination of the interference." 35 U.S.C. § 135(c).


Jameson Lee
Administrative Patent Judge

Filed by: Jameson Lee
Administrative Patent Judge
Mail Stop Interference
P.O. Box 1450
Alexandria Va 22313-1450
Tel: 571-272-9797
Fax: 571-273-0042¹

Filed:
October 21, 2004

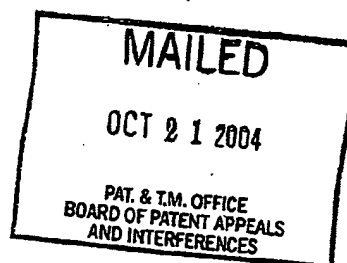
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

TAKESHI MATSUSHITA and
HIROSHI TAYANAKA
Junior Party
(Patent 5,811,348),

v.

KIYOFUMI SAKAGUCHI and
TAKAO YONEHARA
Senior Party
(Application 09/161,774).



Patent Interference No. 105,263

DECLARATION

Part A. Declaration of interference

An interference is declared (35 U.S.C. § 135(a)) between the above-identified parties. Details of the application(s), patent (if any), reissue application (if any), count(s) and claims designated as corresponding or as not corresponding to the count(s) appear in Parts E and F of this DECLARATION.

¹ The telephone number until October 6, 2004, is 703-308-9797. The facsimile number until October 6, 2004, is 703-305-0942.

Part B. Judge managing the interference

Administrative Patent Judge Jameson Lee has been designated to manage the interference. 37 CFR § 41.104(a) [Bd. R. 104(a)].

Part C. Standing order

A Trial Section STANDING ORDER [SO] accompanies this DECLARATION.

The STANDING ORDER applies to this interference.

Part D. Initial conference call

A telephone conference call to discuss the interference is set for **10:00 a.m. on December 16, 2004** (the Board will initiate the call).

No later than **two business days** prior to the conference call, each party shall file and serve by facsimile (SO ¶ 4.5) a list of the motions (Bd. R. 120; Bd. R. 204; SO ¶ 26) the party intends to file.

A sample schedule for taking action during the motion phase appears as Form 2 in the STANDING ORDER. Counsel are encouraged to discuss the schedule prior to the conference call and to agree on dates for taking action. A typical motion period lasts approximately eight (8) months. Counsel should be prepared to justify any request for a shorter or longer period.

Part E. Identification and order of the parties

Junior Party

Named inventors: Takeshi Matsushita, Kanagawa, Japan
Hiroshi Tayanaka, Kanagawa, Japan

Patent: 5,811,348, issued September 22, 1998
based on application 08/595,382, filed
February 1, 1996

Title: Method for separating a device forming
layer from a base body

Assignee: Sony Corporation

Accorded Benefit: None

Senior Party

Named Inventors: Kiyofumi Sakaguchi, Isehara-Shi, Japan
Takao Yonehara, Atsugi, Japan

Application: 09/161,774, filed September 29, 1998

Title: Process for production of semiconductor
Substrate

Assignee: None

Accorded Benefit: Application 09/863,717, filed May 27, 1997

Application 08/401,237, filed March 9, 1995

Japanese Application 7-045441, filed
March 6, 1995

Japanese Application 6-039389, filed
March 10, 1994

The senior party is assigned exhibit numbers 1001-1999. The junior party is assigned exhibit numbers 2001-2999. Bd. R. 154(c)(1). The senior party is responsible for initiating settlement discussions. SO ¶ 18.

Part F. Count and claims of the parties

Count 1

Claim 97 of Sakaguchi's Application No. 09/161,774

or

Claim 1 of Matsushita's Patent 5,811,348

The claims of the parties are:

Matsushita: 1-11

Sakaguchi: 97-104

The claims of the parties which correspond to Count 1 are:

Matsushita 1-7 and 9-11

Sakaguchi 97-104

The claims of the parties which do not correspond to Count 1, and therefore are not involved in the interference, are:

Matsushita 8

Sakaguchi None

Part G. Heading to be used on papers

The heading in SO Form 1 must be used on all papers filed in this interference.

See SO ¶ 7.2.1. The administrative patent judge and parties must be indicated as follows:

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**
(Administrative Patent Judge Jameson Lee)

**TAKESHI MATSUSHITA and
HIROSHI TAYANAKA**
Junior Party
(Patent 5,811,348),

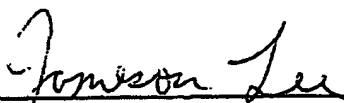
v.

**KIYOFUMI SAKAGUCHI and
TAKAO YONEHARA**
Senior Party
(Application 09/161,774).

Patent Interference No. 105,263

Part H. Order form for requesting file copies

When requesting copies of files, use of SO Form 4 will greatly expedite processing of the request. Please attach a copy of Part E of this DECLARATION with a hand-drawn circle around the patents and applications for which a copy of a file wrapper is requested.


Jameson Lee
Administrative Patent Judge

Enc:

Copy of STANDING ORDER
Form PTO-850
Copy U.S. Patent 5,811,348
Copy of claims of 09/161,774

Revised September 2004

cc (via overnight delivery):

Attorney for Matsushita

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233 South Wacker Drive
Sears Tower
Chicago, IL 60606

Attorney for Sakaguchi:

FITZPATRICK CELLA HARPER & SCINTO
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New York, NY 10112

**THIS DOCUMENT WAS NOT WRITTEN FOR PUBLICATION
AND IS NOT BINDING PRECEDENT OF THE BOARD**

Filed by: Trial Section Merits Panel
Mail Stop INTERFERENCE
Board of Patent Appeals and Interferences
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, Virginia 22313-1450
Tel: 571-272-9797 Fax: 571-273-0042

Paper No. **14**
Entered October 27, 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

**TAKESHI MATSUSHITA and
HIROSHI TAYANAKA**
Junior Party
(Patent 5,811,348)¹

FAXED

09/27/2005

v.

**KIYOFUMI SAKAGUCHI and
TAKAO YONEHARA**
Senior Party
(Application 09/161,774)²

**PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES**

Patent Interference No. 105,263

Before SCHAFFER, LEE, and MOORE, Administrative Patent Judges.

LEE, Administrative Patent Judge.

Judgment – Bd. Rule 127(b)

¹ Based on Application 08/595,382, filed February 1, 1996. The real party in interest is Sony Corporation.

² Filed September 29, 1998. Accorded the benefit of Application 08/863,717, filed May 27, 1997; Application 08/401,237, filed March 9, 1995; Japanese Application 7-045441, filed March 6, 1995; and Japanese Application 6-039389, filed March 10, 1994. The real party in interest is Canon Kabushiki Kaisha.

Interference No. 105,263
Matsushita v. Sakaguchi

Junior party Matsushita filed a paper conceding priority to the senior party as to the subject matter of the count. (Paper No. 29) Junior party Matsushita also filed Substantive Motion 1 seeking to designate its involved claims 6, 7 and 9 as not corresponding to the count. The motion has been denied. (Paper No. 40) The concession of priority is treated as a request for entry of adverse judgment. The request is herein granted.

It is

ORDERED that judgment as to the subject matter of Count 1 is entered against junior party TAKESHI MATSUSHITA and HIROSHI TAYANAKA;

FURTHER ORDERED that junior party TAKESHI MATSUSHITA and HIROSHI TAYANAKA is not entitled to its patent claims 1-7 and 9-11 which correspond to Count 1;

FURTHER ORDERED that if there is a settlement agreement, the parties should note the requirements of 35 U.S.C. § 135(c) and Bd. Rule 205; and

FURTHER ORDERED that a copy of this judgment be placed in the respective involved application or patent of the parties.

Interference No. 105,263
Matsushita v. Sakaguchi

/ss/ Richard E. Schafer
RICHARD E. SCHAFFER
Administrative Patent Judge

/ss/ Jameson Lee
JAMESON LEE
Administrative Patent Judge

/ss/ James T. Moore
JAMES T. MOORE
Administrative Patent Judge

**BOARD OF PATENT
APPEALS
AND
INTERFERENCES**

Interference No. 105,263
Matsushita v. Sakaguchi

By Facsimile:

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Counsel for Senior Party Sakaguchi:

212-218-2200 (Fax)
Anthony M. Zupcic, Esq.
FITZPATRICK, CELLA, HARPER & SCINTO
30 Rockefeller Plaza
New York, New York 10112-3800

INTERFERENCE DIGEST

Interference No. 105,263

Paper No. 13

Name: Kiyofumi Sakaguchi et al.

Serial No.: 09/161,774

Patent No.

Title: Process for production of semiconductor substrate

Filed: 09/29/98

Interference with Matsushita et al.

DECISION ON MOTIONS

Administrative Patent Judge, _____ Dated, _____

FINAL DECISION

Board of Patent Appeals and Interferences, *[Signature]* Dated, 10/27/05

Court, _____ Dated, _____

REMARKS

This should be placed in each application or patent involved in interference in addition to the interference letters.